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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772

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OBER / KALER  
c/o Royal W. Craig  
120 East Baltimore Street  
Baltimore, MD 21202

EXAMINER

DEVOTI, PAUL D

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/825,836

Applicant(s)

HORTON, WADE C.

Examiner

Paul Devoti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6,7,9-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Regarding the drawing objection in the previous office action: the examiner agrees with the applicant's argument that the recessed lighting fixture is shown in dashed lines and referenced as reference number 21. Therefore, the previous drawing objection is removed and the drawings filed on 17 April 2004 are acceptable.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 7, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1 and 7, the inset article, finishing ring, and cutout are all recited as intended use. Only an accent frame per se is positively recited (line 1). The limitations of the inset article, finishing ring, and cutout render the claim indefinite, as they are not positively recited. It is unclear whether claim 1 is directed towards an accent frame per se, or a combination of an accent frame and an inset article (including a recessed lighting fixture), finishing ring, and cutout. If the applicant intends to claim such a combination, the claims should be amended accordingly. For the purposes of examination, the examiner is considering the subcombination of the accent frame, and

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any recitation of an accent frame in combination with an inset article, finishing ring, and cutout will not be given any patentable weight.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-7, 9-10, 13-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lackey (US 5975853) in view of Kelmelis et al. (US 6474846).

7. Regarding claims 1-2, 9-10, Lackey discloses an accent frame in the form of a rigid, plastic cover, which serves as an aesthetically pleasing backdrop. It is obviously capable of framing an article within a cutout of a structure, and has an object-shaped decorative outer edge (as seen in Figure 1). The cover has an aperture (31), forming an inner edge, corresponding in size to a cutout (A) in a ceiling (C). The cover (10) is obviously capable of being secured in place against a ceiling (C) by a covering plate (P), as seen in Figure 5. Lackey does not disclose the cover has a lip for positioning within a cutout of a structure. Kelmelis, however, discloses a lighting system with a framing member (41) that has a lip (51) extending from an aperture that serves as a guide for positioning. Therefore, it would have been obvious to one having ordinary skill

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in the art at the time of invention to modify Lackey's cover to include a lip extending from the aperture, as taught by Kelmelis to guide the framing member in position.

8. Regarding claims 3-4, Lackey in view of Kelmelis discloses everything previously mentioned, including the cover (10) is seated flush with a ceiling (C) and flares away to provide aesthetically pleasing depth and texture.

9. Regarding claim 6, Lackey in view of Kelmelis discloses everything previously mentioned, but does not disclose the cover is approximately 1 mm thick. It would have been an obvious matter of design choice to make the cover approximately 1 mm thick, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

10. Regarding claim 7, the cover (10) is obviously capable of framing a recessed lighting fixture.

11. Regarding claim 13, Lackey in view of Kelmelis discloses everything previously mentioned, including the cover (10) is decorative with ornamentation (O) and would obviously cover any imperfections in the edges of a cutout not covered by a covering plate (P).

12. Regarding claim 14, Lackey in view of Kelmelis discloses everything previously mentioned, and because the cover (10) is decorative with ornamentation (O), it would be an obvious matter of design choice to make the cover with a specific decoration, such as a star, flower, or house.

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13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lackey (US 5975853) in view of Kelmelis et al. (US 6474846) as applied to claim 1 above, and further in view of Gretz (US 6152413).

14. Regarding claim 11, Lackey in view of Kelmelis discloses everything previously mentioned, but does not disclose the cover is formed by injection molding. Gretz, however, discloses a mounting block with a medallion portion that is plastic and formed from injection molding (column 4, lines 56-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Lackey's cover, already modified by Kelmelis, to be formed from injection molding, as this would provide high strength and make the cover integrally formed.

### ***Response to Arguments***

15. Applicant's arguments filed on 31 July 2006 have been fully considered but they are not persuasive.

16. Regarding applicant's arguments about the subcombination of the accent frame: The applicant has not clearly responded to whether the claims are directed towards an accent frame per se, or an accent frame in combination with an inset article in the form of a recessed lighting fixture, finishing ring, and cutout. The examiner strongly disagrees with the argument that one skilled in the art would readily understand the scope of claim 1. Only the accent frame in the amended claims is positively recited in claim 1. The inset article, finishing ring, and cutout are all recited as intended uses with

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the accent frame, and the limitations of the inset article, finishing ring, and cutout render the claim indefinite. Therefore, the 35 U.S.C. 112 second paragraph rejection is maintained, and the examiner has considered the subcombination of the accent frame for the purposes of examination. Lackey in view of Kelmelis and Gretz clearly discloses all of the limitations of the claims with regard to the accent frame.

17. Regarding applicant's arguments about the decorative outer edge: The cover of Lackey has a decorative outer edge and is in the shape of a circular object. The decorative outer edge is clearly seen as it can be visually "perceived by the senses", and therefore the examiner strongly disagrees with the applicant that the cover is not an object.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Devoti whose telephone number is 571-272-2733. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PD   
10/12/06

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